

REMARKS

I. Claim Status. Claims 1-5 and 19-21 are pending. Claims 3 and 19-21 are allowed.

II. Claim Rejections.

(i) Claim rejections under 35 U.S.C. § 112, first paragraph (written description).

Claims 1, 2, 4 and 5 remain rejected as allegedly containing subject matter that is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed. The rejection is respectfully traversed.

The Examiner's position is that the application only supports substitution of aryl groups and that the optional substitution permitted for choice (iv), the indole ring system, is new matter. Applicants respectfully disagree with the Examiner. The Examiner's position appears to be grounded on a narrow definition of "aryl" that restricts the term to mean only fully carbocyclic aromatic rings, e.g., phenyl or naphthyl. One of ordinary skill in the art, however, would understand that, as used in the specification, the term "aryl" includes an aromatic carbocyclic ring that is fused to a second ring, which may or may not include one or more heteroatoms. Hence, at page 5, lines 21-25, the specification sets forth that:

When B comprises an aryl group, two substituents on the aromatic ring may be connected together to form another ring system. For example, B may be a benzodioxanyl ring. (emphasis added)

Applicants submit that the statement that B may comprise an aryl group that may, in turn, be fused to another ring, conveys to one of ordinary skill in the art that the term aryl is to be applied independently to each ring of fused ring system. This interpretation is supported by

the illustrative example of benzodioxanyl that immediately follows the definition of aryl. Based on the passage set forth above, one ordinary skill in the art would understand that a benzodioxanyl radical comprises an aryl (phenyl) group with two substituents fused to form a second, heteroatom-containing ring. In light of the passage, one of ordinary skill in the art would understand that an indole group comprises a phenyl ring fused to the nitrogen-containing ring that completes the indole group.

In view of the foregoing discussion, one of ordinary skill in the art would understand that the statement:

As used herein with regard to the scope of the variables Ar, Ar', and B, aryl radical means a mono or bicyclic aromatic radical having 6 to 12 carbon atoms (e.g. phenyl or naphthyl) which is optionally substituted by one or more substituents (Specification at page 5, lines 17-19.)

includes the optional substitution of an aryl (e.g., phenyl) group that is part of a larger ring system. Accordingly, with respect to the present rejection, one of ordinary skill in the art would understand that the specification conveys that, at the time the application was filed, the inventors had possession of the compounds claimed in claim 1, wherein, in relevant part, B is indolyl and the phenyl ring of the indolyl group is optionally substituted with one or more of the substituents set forth in the claim.

For the reasons set forth above, Applicants believe the rejections of claims 1, 2, 4 and 5 under 35 U.S.C. § 112, first paragraph should be withdrawn. Applicants respectfully request reconsideration of these claims and withdrawal of all rejections thereof under 35 U.S.C. § 112, first paragraph, accordingly.

(ii) Rejection under 35 U.S.C. § 103(a). Claims 1, 2, 4 and 5 remain rejected as obvious over and Shiota (WO 97/44329). The Examiner's position is that, in view of the pending new matter rejection, the claims cannot be accorded the benefit of priority under 35 U.S.C. § 119 of Italian application no. MI 97 A 001861, filed July 28, 1998. The Examiner has stated that overcoming the new matter rejection would entitle the Applicant to claim priority under 35 U.S.C. § 119. For the reasons set forth above, Applicant believes the new matter rejection has been addressed and overcome. Accordingly, reconsideration of claims 1, 2, 4 and 5 and withdrawal of all rejections thereof under 35 U.S.C. § 103(a) is requested.

CONCLUSION

This application is believed to be in condition for allowance, which is earnestly solicited.

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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